

Docket No. F-7948

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REMARKS

Claims 1-9 remain pending in this application. Claims 1-9 are rejected. The specification has been amended to correct a typographical error.

Claims 1, 3, 4, 8, and 9 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,788,208 (Pearce). The specification has been amended to correct a typographical error.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claim 1 recites shifting the leading end of the multilayered strand substantially into the empty, pre-opened dispenser and Pearce fails to disclose such limitation. The Office Action, on page 2, cites column 4, lines 40-44 of Pearce as disclosing a method including shifting the leading end of the multilayered strand substantially into the empty, pre-opened dispenser. Pearce states, in column 4, lines 39-49, as follows:

From the clamping jaws 34, the sheets pass over a shear plate 36 and under a shear blade 37, operating in timed relation to the printing and feeding mechanism, to shear the several sheets at points substantially midway between successive printed impressions. Successive lengths of the sheet material sheared from the webs by the blade 37 drop onto a delivery chute 38 from which they may be removed by any suitable means. Preferably the delivery chute 38 is actuated by a suitable jogging mechanism 39 for aligning successive groups severed from the advancing webs.

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There is no disclosure in column 4, lines 40-44 that the leading end of the multilayered strand is shifted substantially into an empty, pre-opened dispenser. In fact, the language of "[s]uccessive lengths of the sheet material sheared from the wcb's by the blade 37 drop into a delivery chute 38" demonstrates that in Pearce the sheet material is sheared and that after the shearing the piece that is sheared is dropped into the chute. Thus, Pearce does not disclose shifting an end of the multilayered strand substantially into the dispenser, as recited in claim 1.

Furthermore, claim 1 recites that the strand is cut after shifting the leading end of the strand substantially into the dispenser. As explained above, in Pearce the sheet material is sheared and after being sheared the piece that was cut is dropped into a chute. Thus, Pearce fails to disclose cutting the multilayered strand after the leading end of the multilayered strand is shifted substantially into the dispenser, as recited in claim 1. Accordingly, claim 1 is patentable over Pearce and notice to that effect is respectfully requested. Claims 2-8 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). Claim 8 is also patentable at least because Pearce fails to disclose a dispenser being a two-piece dispenser with a drawer-shaped bottom part and a top-part, as recited in claim 8.

Claim 9 recites shifting the leading end of the multilayered strand substantially into a pre-opened dispenser and recites that after shifting the leading

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end substantially into the dispenser that the multilayered strand is cut. Pearce fails to disclose these two limitations, as explained above. Accordingly, claim 9 is patentable over Pearce and notice to that effect is respectfully requested.

Claims 1-9 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,588,280 (Kotsopoulos) in view of U.S. Patent No. 2,788,208 (Pearce).

To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03. Claim 1 recites aligning and transporting the multilayered strand to a cross cutting device, such that the leading end of the multilayered strand is advanced beyond the cross-cutting device. The Office Action states on page 3 that the method of Kotsopoulos includes "aligning and transporting a strand to a cross-cutting device (36/38, 48/50), such that said leading end of the strand is advanced beyond the cross-cutting device (see col. 5, lines 39-49)." However, Kotsopoulos at column 5, lines 39-45 states that "[a]t a predetermined time, feed rolls 36 and 38 cause the leading edge of the forwardmost coupon 20 to enter the bight 49 between positioning rolls 48 and 50. Positioning rolls 48 and 50 tear the forwardmost coupon 20 from the next succeeding coupon 22 along the perforated line of separation and inject forwardmost coupon 20 at a predetermined location." Thus,

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objects 36 and 38 are "feed rolls" and objects 48 and 50 are "positioning rolls," as disclosed in Kotsiopoulos. Kotsiopoulos fails to disclose or suggest a cross-cutting device, as recited in claim 1. Claim 9 also recites a cross-cutting device, which is not disclosed or suggested in Kotsiopoulos, as explained above. Accordingly, claims 1 and 9 are patentable over the cited art and notice to that effect is respectfully requested. Claims 2-8 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

The Office Action, on page 3, admits that Kotsiopoulos is silent as to how many layers comprise the strand and relies on Pearce for the teaching of a multilayered strand. The Office Action states, on page 4, that it would be obvious to modify Kotsiopoulos by arranging individual tapes into a multilayered strand. The Federal Circuit has stated that there must be suggestion or motivation to combine references. *See In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. The Office Action has failed to demonstrate any suggestion or motivation to combine the references and, accordingly, *prima facie* obviousness has not been met.

Furthermore, the Federal Circuit has stated that generally, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. *See In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994); *see also* MPEP § 2145.

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Kotsiopoulos discloses on column 2, lines 30-34 that an object of the invention is "to provide a coupon inserting apparatus capable of detaching a single coupon from a continuous web" (emphasis added). Thus, Kotsiopoulos teaches away from being modified to have a multilayered strand since only one coupon is to be detached. Accordingly, *prima facie* obviousness is lacking for this reason as well and claims 1-9 are patentable over the cited references.

Although the Office Action is rejecting claims 1-9 over Kotsiopoulos in view of Pearce, the Office Action has not identified where in Kotsiopoulos are taught the limitations recited in claims 2, 5, and 7 and Applicants respectfully request that such information be provided in order to provide Applicants with an opportunity to respond regarding those claims.

Furthermore, claim 4 recites administration forms which contain at least one of therapeutic, cosmetic, and food-technological products. The Examiner has rejected claim 4 based upon both of the cited references by stating "cosmetic (printed on)" on pages 2 and 3 of the Office Action. It is assumed that the Examiner believes that because the cited references pertain to printed webs that they disclose a cosmetic product. However, as the Federal Circuit has stated, "a claim must be read in view of the specification of which it is a part." *Renishaw plc v. Marposs Societa' per Azioni*, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). The specification, on page 1, in the first full paragraph after the title states that "[t]he

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administration forms may for application thereof containing (sic) therapeutic or cosmetic or food-technological products." Thus, it is clear from the specification that the cosmetic product is intended to be administered and would not, under any reasonable interpretation, apply to every single web that has any printing on it, as may be assumed by the Examiner. Thus, the cited references fail to disclose or suggest a cosmetic product, as recited in claim 4.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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